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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Laura Raus

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EXAMINER

WAGGLE, JR, LARRY E

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,721	<b>Applicant(s)</b> RAUS, LAURA	
	<b>Examiner</b> Larry E. Waggle, Jr	<b>Art Unit</b> 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 24, 26-30, 32, 34-35 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 24, 26-30, 32, 34-35 and 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 27-28, 30, 32, 34 and 40-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourne (US Patent 2948174) in view of Garrison (US Publication 2004/0006335).

Bourne discloses a device (Figure 1) comprising a pair of side-by-side blades (38 and 42) slidably coupled (via 36) so that respective distal ends thereof be closable, the one against the other; propelling means (i.e. hydraulic) connected to a slidable blade (42) of the pair comprising a piston (94), a stem (92 and 96) and an intake (89); operation means (62; i.e. trigger); a main body (40) housing the propelling means comprising a portion (i.e. end comprising operation means) handled by a user, wherein the piston is coupled to the slidable blade by interposition of a motion transmission member (98; i.e. lever) rotatably connected at opposed ends (i.e. ends of 97 and 99) to the slidable blade and to the stem of the piston (via 96), the lever being further connected to a chassis (22; i.e. via 102) of the device, the slidable blade is removably connectible (i.e. by the removal of 48) to the propelling means, the slidable blade automatically returns to a resting position (i.e. as shown in Figure 2) when the user releases the operation means and a screw (86; i.e. supply valve) acts as a means for

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adjusting the closing force of the blades, a means for adjusting the relative sliding speed of the blades, and a means for inhibiting operation of the propelling means by being adjustable from any one of numerous positions between fully closed (i.e. tightened) to fully open (i.e. loose) to adjust the flow and therefor pressure of the hydraulic fluid (F) (Figures 1-7 and column 2, line 52 – column 6, line 51).

Bourne discloses the claimed invention except for the propelling means being pneumatic propelling means. Garrison teaches a surgical device (10) comprising a member (16) that reciprocates relative to another member (20), wherein the reciprocating motion is controlled via either a pneumatic pump and motor assembly or a hydraulic pump and motor assembly which are taught as being used interchangeably (paragraph 0022). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Bourne with the use of a pneumatic propelling means in view of Garrison in order to provide an alternative means for controlling the sliding action of the blade that is reasonably pertinent to the particular problem with which the device of Bourne is concerned.

With regard to the statements of intended use and other functional statements, such as “for” and “apt,” they do not impose any structural limitations on the claims distinguishable over Bourne in view of Garrison which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v.*

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Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

**Claims 1, 24, 29, 35, 47 and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US Patent 3752161) in view of Bourne (US Patent 2948174).

Bent discloses a surgical device (Figure 1) comprising a pair of side-by-side blades (20 and 22) slidably coupled (via 32 and 34) so that respective distal ends thereof be closable, the one against the other, the blades also being rotatable (column 4, line 65 – column 5, line 2); pneumatic propelling means (12) connected to a slidable blade (18) of the pair comprising a piston (100 or 104), a stem (114) and an intake (70 and 74 (i.e. means for connecting with a pneumatic supply means)) that acts as a means for adjusting the closing force and, therefore, the sliding speed of the blades that comprises flow adjusting means (i.e. conical section of 184) that depend on the user's speed of handling the operation means (column 9, lines 42-56); operation means (16; i.e. trigger); a main body (10) housing the propelling means comprising a portion (14) handled by a user, wherein the piston is coupled to the slidable blade by a motion transmission member (40), the slidable blade is a plurality of osteotomy blades removably connectible to the propelling means (column 2, lines 60-65); and a means capable of preventing bone entrapment (i.e. space between 20 and 22) (Figures 1-4 and column 3, line 57 – column 4, line 64).

Bent discloses the claimed invention except for the motion transmission member (i.e. lever) being rotatably connected at opposed ends to the slidable blade and to the stem of the piston, the lever being further connected to a chassis of the device. As stated above, Bourne teaches a device comprising all of the claimed limitations to include a motion transmission member (98; i.e. lever) rotatably connected at opposed ends (i.e. ends of 97 and 99) to the slidable blade and to the stem of the piston (via 96), the lever being further connected to a chassis (22; i.e. via 102) of the device (Figures 1-7 and column 2, line 52 – column 6, line 51). A skilled artisan would recognize that replacing the arrangement of the interior components of Bent with the arrangement of the interior components of Bourne would result in the intended results required by the claimed invention (i.e. the slidably coupling of side-by-side blades). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Bent with the device comprising all of the claimed limitations as stated above to include a motion transmission member (i.e. lever) rotatably connected at opposed ends to the slidable blade and to the stem of the piston, the lever being further connected to a chassis of the device in view of Bourne in order to provide an alternative means for controlling the sliding action of the blade that is reasonably pertinent to the particular problem with which the device of Bent is concerned.

With regard to the statements of intended use and other functional statements, such as “for” and “apt,” they do not impose any structural limitations on the claims distinguishable over Bent in view of Bourne which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136

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USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

**Claims 26 and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US Patent 3752161) in view of Bourne (US Patent 2948174) further in view of Vilsmeier (US Patent 6351659).

Bent in view of Bourne disclose the claimed invention except for a neuro-navigation system and means for cooperation with the system. Vilsmeier teaches a neuro-navigation system (see figure 1) and means for cooperation with the system (21 or 22) attached to an instrument 20 in order to supply a link between the surgeon and diagnostic data (see col. 1, l. 25-30). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Bent in view of Bourne with the neuron-navigation system and means for cooperation with the system in view of Vilsmeier in order to supply a link between the surgeon and diagnostic data.

**Claim 46** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bent (US Patent 3752161) in view of Bourne (US Patent 2948174) further in view of De Satnick et al. (US Patent 4848338).

Bent in view of Bourne disclose the claimed invention except for a means for inhibiting operation of the propelling means. De Satnick et al. teach a surgical instrument with means for (i.e. 46) inhibiting operation of propelling means in order allow the user the option of keeping blade members (embodied by 15 and 19) closed (col. 6, l. 51-63). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Bent in view of Bourne with the means for inhibiting operation of the propelling means in view of De Satnick et al. in order allow the user the option of keeping blade members closed.

### ***Response to Arguments***

Applicant's arguments, see pages 1-3, filed 13 April 2009, with respect to the rejection(s) of claim(s) 1, 24, 26-30, 32, 34-34 and 40-49 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the prior art listed above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry E Waggle, Jr/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775